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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,260

07/24/2003

Robert Greenberg

S202-USA

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06/10/2010

SECOND SIGHT MEDICAL PRODUCTS, INC.
12744 SAN FERNANDO ROAD
BUILDING 3
SYLMAR, CA 91342

EXAMINER

BLATT, ERIC D

ART UNIT

PAPER NUMBER

3734

NOTIFICATION DATE

DELIVERY MODE

06/10/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SCOTTD@2-SIGHT.COM
REVANS@2-SIGHT.COM

Office Action Summary	Application No. 10/627,260	Applicant(s) GREENBERG ET AL.	
	Examiner Eric Blatt	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2-26-2010 has been entered.

Claim Objections

Claim 1 is objected to because of the following informalities: claim 1 recites a base portion coupled to the *back surface* wherein this should read *back interior surface*. Claim 1 additionally recites the *bottom portion* wherein this should read *base portion*. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 8, 11, 20, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Shippert (US 5,507,807).

Shippert discloses a surgical tool capable of being used for implantation of an electrode array (Figures 3-6) comprising a frontally closed end portion 48 having a curved shape, the curved shape defining a rounded front exterior surface and a back interior surface opposite the rounded front exterior surface, a base portion 76 coupled to the back interior surface at a first location, and a top portion 24 coupled to the back interior surface at a second location. The base portion 76 is coupled to the back interior surface of the end portion 48 by means of coupling means 72, 82. A point near the distal end of coupling means 72, 82 may be interpreted to comprise the claimed first location. The distance between the first location and the second location defines an open space capable of receiving and protecting an electrode array. The top portion 24 and the base portion are movable with respect to each other to gently grip and hold an electrode array. The open space is between the base portion and the top portion, and in an operating condition, the base portion is substantially parallel to the top portion. The open space defines a lateral opening of the surgical tool through which an implant may be released. (Figure 6)

Regarding claim 5, the top portion and base portions have portions on their outer surfaces that are curved and portions on their inner surfaces that are substantially flat.

Regarding claim 6, there is a keeper 88 connected to the base portion 76 to limit travel of the top portion 24.

Regarding claim 20, the base portion 76 is concave in one dimension and convex in another while the top portion 24 is convex in two dimensions. (Figure 3)

Regarding claim 24, the electrode array is functionally recited and is not considered to be positively claimed. Shippert discloses a first operating condition (when contact wedge 64 is located proximally as seen in Figure 4) for allowing retention of an electrode array and a second operating condition (when contact wedge 64 is being advanced as seen in Figure 6) for allowing release of an electrode array through the lateral opening. In both operating conditions, the distance between the base portion and the top portion is controlled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shippert (US 5,507,807).

Regarding claim 2, as disclosed in Shippert, the tool must be disassembled in order to load an implant 40 between the top and base portions. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a hinge between the front end portion and the top portion so that an implant could be easily loaded into the delivery chamber without disassembling the device.

Regarding claim 7, Shippert discloses tracks 72a and 72b in the top portion that meet guides 82a and 82b in the base portion to latch the base and top portions together. It would have been obvious provide the tracks on the base portion and the guides on the top portion since such a modification would merely constitute a reversal of parts. The tracks comprise notches.

Regarding claims 9 and 10, it would have been obvious to one of ordinary skill in the art to fashion the tool of Shippert from ABS or stainless steel since it has been held that selecting a material known to be suitable for an intended purpose merely requires ordinary skill in the art.

Claims 4, 12-19, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shippert (US 5,507,807) in view of Hughes (US 6,579,256).

Shippert teaches all elements of claims 4, 12-19, 22, and 26 except for the device being curved to approximate the radius of an eye and that the tool being used to deliver an electrode array into an orbital socket. Hughes teaches a similar delivery apparatus wherein the device is curved to approximate the radius of an eye, and teaches using said apparatus for delivery an electrode array into an orbital socket. (Figures 2-12 and Col. 4, Lines 33-37) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus and method of Shippert by curving the top and base portions to approximate the radius of an eye and using said the tool for delivering an electrode array into an orbital socket in order to restore a degree of vision to a patient as taught by Hughes.

Specifically regarding claim 17, Shippert discloses that the top and base portions slide relative to one another to allow an implant to be placed therebetween. It would have been obvious to one of ordinary skill in the art at the time of the invention to instead hingedly couple the top and base portions together since this would be a functionally equivalent mechanism for allowing access to the chamber between the top and base portions.

Response to Arguments

Applicant's arguments 2-26-2010 have been fully considered but they are not persuasive.

Applicant has merely stated that the Shippert would not be an effective tool for implantation of an electrode array and suggests that the plunger arrangement would damage a delicate electrode array and not allow space for the electrode array's cable. In response, Examiner notes that the dimensions and characteristics of the electrode array are not specified in any of the claims, so it would seem that at least some size of electrode could fit within the Shippert device. With regard to Applicant's assertion that plunger arrangements are not suitable for delivery of an electrode array, the Hughes reference that is relied upon for the teaching of the electrode array discloses a plunger arrangement not dissimilar from that of Shippert precisely for delivering an electrode. (See Abstract of Hughes)

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. B./

Examiner, Art Unit 3734

/TODD E. MANAHAN/

Supervisory Patent Examiner, Art Unit 3734